

at least one cross-member extending between and attached to the lower portions of the support members, the cross-member positioned so as to be between successive wheels;

an upper portion in the forefoot section of each support member, the upper portion extending upwardly from the lower portion and having an upper edge, and a mounting flange extends from each upper edge, the mounting flange having at least one mount hole; and

an upper portion in the heel section of each support member, the upper portion extending upwardly from the lower portion and having an upper edge, and a mounting flange extends from each upper edge, the mounting flange having at least one mount hole;

wherein in at least one of the heel and forefoot sections, the upper portions lie in substantially convergent planes in an upwardly extending direction above the at least one cross-member.

### COMMENTS

In response to the Office Action mailed October 4, 2001, Applicants respectfully request the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following comments.

#### Offer to Surrender Has Been Submitted

The Examiner indicated that the application was filed without the required offer to surrender the original patent. Such an Offer to Surrender was filed on April 26, 2001. A copy of the Offer to Surrender and the accompanying Transmittal letter are included herewith.

#### Claims 13 and 16-28 Do Not Improperly Recapture Surrendered Subject Matter

The Examiner rejected Claims 13 and 16-28 under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the parent application. Applicants disagree with at least part of the Examiner's contentions. Claim 13 has been amended to add the text -- above the at least one cross-member -- on line 20 after the word "direction".

In the rejection, the Examiner notes that Claim 5 of the '369 patent recites "one or more web members extending between . . .", which phrase was added to Claim 5 during prosecution to

overcome a rejection. Reissued Claims 13 and 22 both recite "at least one cross-member extending between . . .". The Examiner contends that use of the term "cross-member" instead of "web" constitutes recapture of surrendered subject matter. Applicants respectfully disagree with the Examiner's contention and traverse the rejection.

The Examiner cited In re Clement, 45 USPQ2d 1161 (Fed. Cir. 1997) and Ball Corp. v. United States, 221 USPQ 289 (Fed. Cir. 1984) in support of the assertion of recapture. Applicants contend that, like the patentee in Ball, Applicants have not attempted to recapture surrendered subject matter.

The Clement case set forth the following principle:

(3) if the reissue claim is broader in some aspects, but narrower in others, then (a) if the reissue claims is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim. Clement, at 1165.

On page 1165 of Clement, the court discussed the Ball case and showed how the patentee in Ball was an example of (3)(b). In Ball, the issued claim recited "a plurality of feedlines". The canceled (pre-amended) claim recited "feed means includ[ing] at least one conductive lead". The patentee added the "plurality of feedlines" limitation to overcome prior art. The reissued claim did NOT have the "plurality of feedlines" limitation, but included another limitation related to the feed means. The court stated, "The reissue claim included limitations not present in the canceled claims that related to the feed means element, but allowed for multiple feedlines. On balance, the claim was *narrower than the canceled claim with respect to the feed means aspect*." Clement, at 1165 (emphasis added). The claim was also broader with respect to other subject matter not related to the feed means aspect. The Ball court reasoned that the patentee was not attempting to recapture surrendered subject matter, and allowed the reissue claim. The Clement court used the Ball case as an example of (3)(b). As such, reissue claims need not retain the exact limitations added during prosecution so long as the reissue claim is narrower in some way connected with the aspect that was amended during prosecution.

Applicants' reissue claims are similar to the situation discussed in Ball. Prior to amendment, Claim 2 (which issued as Claim 5) recited "members having upper and lower

portions, said upper portions . . .”. After amendment, the claim read “members having upper and lower portions separated by one or more web members extending between said longitudinal members, said upper portions . . .”. Reissued Claim 13 recites “at least one cross-member extending between and attached to the lower portions . . .”, and Reissued Claim 22 recites “at least one cross-member extending between the left and right chassis members . . .”. Both reissue claims include limitations not present in the pre-amended Claim 2 (issued Claim 5), which limitations relate to a member extending between lower portions and chassis members, respectively. Thus, *on balance, the reissue claims are narrower than the pre-amended Claim 5 with respect to this aspect*. Like Ball, this matter falls under (3)(b), and the recapture rule does not bar the claim.

The Examiner also notes that Claim 5 of the ‘369 patent recites “a pair of laterally spaced longitudinal members”. Prior to amendment, Claim 2 (issued as Claim 5) recited “a pair of longitudinal members”. Reissued Claim 13 recites “a pair of elongate, spaced apart members”. The Examiner stated that “spaced apart” is broader than “laterally spaced”, and this substitution of terms constitutes recapture. Applicants respectfully contend that this situation is substantially similar to the situation in Ball, and that the recapture rule does not bar the claim. More specifically, Reissue Claim 13 includes a narrowing limitation (“spaced apart”) *not present in the pre-amended Claim 2* (issued Claim 5), which limitation relates to the relationship between two members. Thus, *on balance, Reissue Claim 13 is narrower than the pre-amended Claim 5 with respect to this aspect*. Accordingly, this claim falls under (3)(b) of Clement, and the recapture rule does not bar the claim.

### CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims.

Appl. No. : 09/669,869  
Filed : September 21, 2000

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The undersigned has made a good faith effort to respond to all of the rejections in the case. If any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicants' attorney in order to resolve such issue promptly.

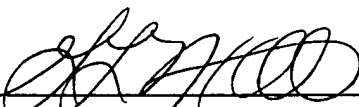
Respectfully submitted,

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Dated: \_\_\_\_\_

4/4/02

By: \_\_\_\_\_



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